

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

A-6585

Application Number

09/590,904

Filed

06-09-2000

First Named Inventor

Jerding et al.

Art Unit

2623

Examiner

Shang, Annan Q

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☐

attorney or agent of record.

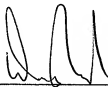
Registration number

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

47,034



Signature

David Rodack

Typed or printed name

(770) 933-9500

Telephone number

January 23, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:

Jerding, *et al.*

Confirmation No.: 1598

Group Art Unit: 2623

Serial No.: 09/590,904

Examiner: Shang, Annan Q.

Filed: June 9, 2000

Docket No. A-6585 (191930-1180)

For: **PROGRAM INFORMATION SEARCHING SYSTEM FOR INTERACTIVE PROGRAM  
GUIDE**

**REMARKS IN SUPPORT OF  
PRE-APPEAL BRIEF CONFERENCE**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Applicants submit the following remarks in support of a Request for a Pre-Appeal Brief  
Conference.

## **REMARKS**

Claims 2, 3, 5-30, 32-37, 39-54, and 59-64 are currently pending and subject to a final rejection based on the final Office Action dated September 13, 2007, the finality of the rejection maintained in the Advisory Action dated January 4, 2008. For purposes of the pre-appeal brief conference, Applicants respectfully submit that there exists clear cases of error and the omission of essential elements in this rejection, supported by the evidence in the record. Although Applicants believe errors in the rejection are evident for all claims, for purposes of conciseness in the pre-appeal brief conference, Applicants address the errors in the 103(a) rejection using a representative sample of claims, and in particular, independent claims 63 and 64.

### **I. 35 U.S.C. § 112, first paragraph**

The final Office Action alleged the following (page 2, section 1):

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 63 and 64, it is unclear as to where support is found for the claimed "...browse-by icon..." recited in claims 63 and 64. There is no disclosure for the claimed "browse-by icon." Furthermore the specification and figures as originally presented do not illustrates[sic] the claimed "browse-by icon."

In the response to final dated November 13, 2007, Applicants provided an Exhibit A, corresponding to a marked-up version of Figure 4 of the original disclosure, with the "icon" encircled and labeled to assist the Examiner, and explained on page 14 of the response to final that exact terminology between specification and claims is not required, that the MPEP 2163 recognizes implicit and inherent disclosure of the claim limitation, and that even assuming *arguendo* there is no explicit disclosure shown and described in association with Exhibit A, the disclosure of the limitation "browse-by-icon" is at least implicit. The Advisory

Action dated January 4, 2008 expressed that the Exhibit was considered, but disagreed with Applicants arguments, asserting that the "Exhibit A does not illustrate the claimed limitation 'BROWSE BY ICON'" and further asserting that there is "no disclosure for the claimed limitation 'browse-by-icon'. Hence the 103(a) rejection is proper."

Applicants respectfully believe there to be clear factual error. As set forth on page 14 of the response to final, one having ordinary skill in the art would recognize that the letter symbols A, B, and C shown in Figure 4 (Exhibit A) and described in the specification are "icons," at least since the term "icon" is a well-understood term in display and GUI technology. Further, as shown in Figure 4 (Exhibit A), the phrase "browse-by" appears adjacent to the icon, "A." Hence, one having ordinary skill in the art would recognize the limitation "browse-by-icon" to be disclosed. Additionally, as set forth on page 13 of the response to final, the disclosure of the limitation may be express, or inherent, or implicit. Even assuming *arguendo* that the disclosure of the limitation is not express, despite the clear illustration in Figure 4 (Exhibit A), Applicants respectfully submit (as set forth on page 14 of the response to final) that the limitation at issue is at least implicitly disclosed. Accordingly, Applicants respectfully request that the rejection be withdrawn in view of the clear factual error.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

With regard to the rejection of independent claims 63 and 64 and as set forth on pages 16 and 22 of the response to final, Applicants respectfully submit that there is clear factual error and omission of essential elements. For instance, on page 3 of the final Office Action, the following is alleged (emphasis added):

Present the initial IPG arrangement on a display device, the initial IPG arrangement including a channel area, a first program display area adjacent the channel area, and a browse area; receive a first user input corresponding to selection of the browse area

Applicants do not claim that the "initial IPG arrangement" includes a browse-by area, but rather, a **browse-by icon**. Likewise, the first user input corresponds to the selection of a **browse-by icon**, not browse-by area. In other words, Applicants respectfully submit that the final Office Action (page 3) improperly examined the claim based on "browse-by-area," not **browse-by-icon**. For at least the reason that there is clear factual error, Applicants respectfully request that the rejection be withdrawn.

Additionally, as set forth on pages 16 and 22 for claims 63 and 64, the absence of examination in the final Office Action on the limitation of **browse-by-icon** results in an improper omission of one or more essential elements necessary for a prima facie rejection, and hence for at least this reason, Applicants respectfully request that the rejection be withdrawn.

In view of the foregoing, Applicants respectfully submit that there exists clear factual error and the omission of one or more essential elements necessary for a prima facie rejection.

**CONCLUSION**

Favorable reconsideration and allowance, or the re-opening of prosecution on the merits, of the present application and claims 2, 3, 5-30, 32-37, 39-54, and 59-64 are hereby courteously requested.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER  
& RISLEY, L.L.P.**

By: \_\_\_\_\_/dr/

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